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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dirk Fischer et al.
Serial No.: 10/685,367
Filed: October 13, 2003
For: METHOD FOR THE PRODUCTION OF A MULTILAYER PLASTIC IDENTITY CARD

Examiner: W. Fridie Jr.
Art Unit: 3722
Confirmation No. 4387

SUBMISSION UNDER 37 C.F.R.1.114

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.10

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Date: June 28, 2005

Jean Bové
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FULBRIGHT & JAWORSKI
555 S. Flower St., Suite 4100
Los Angeles, CA 90071

Mail Stop Response
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the final Office Action mailed March 23, 2005 and Advisory Action mailed May 27, 2005, the following is provided as a submission with a Request for Continued Examination.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

The amendment submitted May 13, 2005 is resubmitted in the accompanying Request For Continued Prosecution. The following remarks address the NOTE referred to in paragraph 3 of the Advisory Action.

In refusing to enter the amendment to claim 7 in the May 13, 2005 response, the Examiner stated that the amendment would raise questions under both 35 U.S.C. §112 and 35 U.S.C. §103 as to what specific additive applicant is claiming. He asked what defines the group containing silica, silicates and calcium carbonate, and inquired as to whether there are other additives in this group that are analogous to the ones claimed.

Respectfully, it is believed that these contentions and questions are improper. The claims are properly crafted Markush claims, under *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925. See M.P.E.P. 2173.05(h), which states in relevant parts:

> "*Ex parte Markush* sanctions claiming a genus expressed as a group consisting of certain specified materials. .....
>
> "The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property."

Here, the members of the group, described in paragraph [0012] of the specification, all have at least one property in common that is responsible for their function in the claimed relationship, a property that is also set forth in claim 7, namely increasing friction between the covering layer and the card core layer, as described in paragraph [0011] of the specification.

Moreover, the friction, i.e., anti-slip, imparting property is also art recognized; see the abstracts of:

> US Patent 5,132,356: "addition of the fumed silica additionally improves several properties of the polyester film, including the static coefficient of friction of the film."
>
> US Patent 6,517,624 : "a frictionizing composition for imparting long-term anti-slip properties to the surface of a paper product comprising an aqueous sol of colloidal silica, glycerin, and at least one agent selected from the

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group consisting of N-methyl pyrrolidone, N,N-dimethyl acetoacetamide, urea, sorbitol, fructose and dextrose."

US Patent 5,433,774: "A friction lining comprising an inorganic silicate-containing binder without resin binder components, comprising a mixture of finely divided SiO_2 (constituent a) and at least partially water-soluble silicates (constituent b)."

US Patent 5,786,077: "An aqueous anti-slip coating composition for paper includes 10-50% by weight insoluble silicate particles of 180-300 millimicron average particle size, and 0.5-10% by weight dispersant."

US Patent 4,990,188: "The coefficient of friction between floors and shoes, particularly in food plants, can be increased by applying thereto, an anti-slip composition comprising sodium bicarbonate and an abrasive, preferably calcium carbonate."

No issues remaining, applicants respectfully solicit a Notice of Allowance.

Respectfully submitted,

Date: June 28, 2005

Robert Berliner
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